



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,232	09/18/2001	Todd Mark Kelsey	ROC920010197US1	8310

7590 02/10/2006

Gero G. McClellan
Moser, Patterson & Sheridan, L.L.P.
Suite 1500
3040 Post Oak Boulevard
Houston, TX 77056-6582

EXAMINER

AYELE, MARIO

ART UNIT PAPER NUMBER

2622

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/955,232	Applicant(s) KELSEY, TODD MARK	
	Examiner Mario Ayele	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

174

DETAILED ACTION

Response to Amendment

Applicant's amendment received on 10/28/05 has been entered and made record. Currently, claims 1-32 are pending.

Response to Arguments

Applicant's arguments, see pages 1-3, filed 10/28/05, with respect to the rejection(s) of claims(s) 1-32 under 35 U.S.C. 102 (b) as being anticipated by Wakai et al. (US 2002/0065871) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wakai et al. and Kim (U.S. Patent 6,373,586).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakai et al. (US 2002/0065871) in view of Kim (US Patent 6,373,586) and Rose (US Patent 5,200,816).

Regarding claim 1 Wakai et al. discloses “monitoring for a print request” in paragraph 0235, line 1 and “intercepting a print file generated from the print request” in paragraph 0239, lines 3-5. Wakai et al. also shows “matching the print file with stored data identification” in paragraph 0054, lines 1-5 and 0068 lines 1-6.

However, Wakai et al. fails to expressly disclose “transforming a print file in accordance to stored print options” and “the transformed print file produces a printed output different from a printed output that would have been produced by the print file generated by the print driver”

Kim discloses “transforming a print file in accordance to stored print options” in column 4, lines 47-54.

Rose discloses, “ the transformed print file produces a printed output different from a printed output that would have been produced by the print file generated by the print driver” in column 26, lines 3.

Wakai et al. Kim and Rose are combinable because they are from the same field endeavor, dealing with printing. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the inventions of Wakai et al. and Kim and Rose because this would create give the user the print the original document or the document as it relates to the stored print options.

In claim 2 Wakai et al. discloses, "at least on print configuration data file configured to store the data identification and prints options" in figure 135. Wakai et al. also shows "a printing module configured for monitoring a print request" in paragraph 0235, lines 1-2. The last part of claim 2 "a transformation program module configured for transforming the print file" can be referenced in Wakai et al. in paragraph 0275, lines 1-7.

Claim 3 goes further into detail about the matching step in claim 1, the first part states, "identifying data identification in the print request", this step can be found in the Wakai et al. drawings, figure 22, step S2201. Later in the second part of the claim "comparing said data identification in the print request to the stored data identification in a currently selected print configured data file" is referenced in Wakai et al. in figure 39, step S3901. The identifying occurs in S2201 and comparing with stored identification in S3901.

In claim 4 Wakai et al. discloses 'further comprising printing the transformed print file to an output device in paragraph 0246, lines 1-4.

In claim 5, Wakai et al. shows an "output device is selected from the group consisting of a printer, a copier, and a scanner" in figure 7, elements 702, 704.

In claim 6, Wakai et al discloses, "stored data identification and print options are user configured" in figure 117, shows location of printer for file to be printed (data identification) and figure 119 "print setup change menu"(window shows options for adjusting object).

In claim 7 Wakai et al displays "prior to the monitoring step, the method further comprises the step of receiving the data identification options" in figure 22, S2201 (job id) "and print options" in figure 22, S2201 (action id) "from a graphical user interface generated by a print option formatting module" in figure 117, shows location of printer for file to be printed (data identification) and figure 119 "print setup change menu"(window shows options the adjust object), the print options.

In claim 8, the rational provided in rejections 1 and 7 are incorporated herein.

In claim 9, Wakai et al. teaches "the print file is a spooled print file in paragraph 0271, lines 1-5.

In claim 10, Wakai et al. teaches print file is configured by print drivers prior to the transforming step in paragraph 0256, lines 3-4, specifically " the request manger permits printer control unit to control printer" after "user manipulates the device A" (printer), in paragraph 0255, line 1.

In claim 11, the rational provided in the rejections of claim 1 is incorporated herein. In addition, Wakai et al. teaches "computer-readable medium comprising a print medium formatting program" executed by a processor in paragraph 0002, lines 1-5.

In claim 12, the rational provided in the rejections of claims 2 and 11, are incorporated herein.

In claim 13, the rational provided in the rejections of claims 3 and 11 are incorporated herein.

In claim 14, the rational provided in the rejections of claims 4 and 5 and 11 are incorporated herein.

In claim 15, the rational provided in the rejections of claims 6 and 11 are incorporated herein.

In claim 16, the rational provided in the rejections of claims 7 and 11 are incorporated herein.

In claim 17, the rational provided in the rejections of claims 7 and 11 are incorporated herein

In claim 18, the rational provided in the rejections of claims 10 and 11 are incorporated herein.

The rational provided in the rejections of claim 18 is incorporated herein claim 10. In addition, Wakai et al. teaches "computer-readable medium comprising a print medium formatting program" executed by a processor in paragraph 0002, lines 1-5.

In claim 19, the rational provided in the rejections of claims 1 and 11 are incorporated herein.

In claim 20 Wakai et al. teaches "computer system" and "processor is configured to execute a print command to print the transformed print file to at least one output device coupled to the computer system", in paragraph 0006, lines 1-3.

In claim 21, Wakai et al. discloses "at least one output device" as a printer in paragraph 0262 lines 1-4.

In claim 22, the rational provided in the rejections of claim 20 is incorporated herein. In addition Wakai et al. teaches "the print medium formatting program is loaded and accessible from a program selected from the group consisting of an operating system, a device driver, and an applications program" in figure 6 element 201, the

Art Unit: 2622

operating unit, which shows the relationship with the request manager interacting with the print medium formatting program. Thus proving it inherently known that the operating unit is accessible to the print medium formatting program.

In claim 23, the rational provided in the rejections of 12 and 20 are incorporated herein.

In claim 24 Wakai et al. teaches "the data identification comprises" in paragraph 0262(description of figure 7), data devices which are identified. Then later in the claim "the at least one output device", Wakai et al. discusses the printer as one output device, in lines 1-4 of the same paragraph.

In claim 25 Wakai et al discloses, "the print options include selectable print color, resolution, size, pages per page, and the printable content", in figure 135 (Size, Object Count, Content) and figure 119 (Color).

In claim 26 Wakai et al teaches "the printable content" can be text only disclosed in paragraph 0276, lines 1-3.

In claim 27, the rational provided in the rejections of 1, 3, and 7 are herein.

In claim 28 Wakai et al teaches, "Received data identification and print options are user configured by a user via at least one GUI" in figure 117(location of printer for file to be printed) and figure 119 "print setup change menu"(window shows options for adjusting object).

In claim 29 Wakai et al. shows "the displaying step further comprises at one of the steps selected in the group consisting of: creating a new print configuration data file, editing an existing print configuration data file, deleting an existing print configuration

Art Unit: 2622

data file, and accepting a current print configuration data file" in figure 113, the option to delete a job is shown.

In claim 30, the rational provided in the rejection of claim 4 is herein.

In claim 31, the rational provided in the rejection of claim 5 is herein.

In claim 32, the rational provided in the rejection of claim 5 is herein.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mario Ayele whose telephone number is 571-272-0624. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mario Ayele
Examiner
Art Unit 2622

A handwritten signature in black ink, appearing to read 'Mark Zimmerman', with a long horizontal flourish extending to the right.

MARK ZIMMERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600